

SUPPORT FOR THE AMENDMENTS

Claims 1-37, 49, 50, 66 and 67 were previously canceled without prejudice.

Claims 72 and 73 are canceled herein without prejudice.

Claims 55-65 and 68-71 have been amended to be written as a pharmaceutical preparation. Support for this amendment is provided by the corresponding previously pending claims and the specification as originally filed.

No new matter is believed to have been entered.

REMARKS

Claims 38-48, 51-65, 68-71, and 74 are pending in the present application.

At the outset, Applicants wish to thank Examiner Loewe for the helpful and courteous discussion with their undersigned Representative on April 5, 2010. During this discussion, various amendments and arguments were discussed to address the outstanding rejections. The content of this discussion is believed to be reflected in the amendments and remarks herein. Reconsideration of the outstanding rejections is requested in view of the amendments and remarks herein.

The rejection of Claims 55-65 and 68-71 under 35 U.S.C. §112, first paragraph (enablement), is obviated by amendment.

The Office continues to alleges that the specification does not enable one skilled in the art to make and/or use the thrombopoietin receptor activators of claims 55-65 and 68-71, the pharmaceutical preparation comprising a thrombopoietin receptor activator of claim 72, and the platelet increasing agent comprising a thrombopoietin receptor activator of claim 73.

The Examiner alleges that the claims fail to meet the enablement requirement because “the claimed compositions are for treatment of diseases which involve the thrombopoietin receptor... the specification does not enable the use of the compounds for the treatment of the diseases.” Applicants submit that the claims in question are, in their essence, compound and/or composition claims which do not rely upon the intended use to define the structure. Applicants again remind the Examiner of the Office’s current position regarding statements of intended use is that “language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a

claim or claim limitation” (see MPEP 2106, IIC - emphasis added). Accordingly, the Office’s enablement analysis with respect to the intended use of the *claimed compositions* is irrelevant to the patentability of *compositions* because intended uses do not limit the scope of the claims. The Examiner openly recognizes that the specification enables the compounds in the absence of the intended use, thus recognition of enablement should also be provided.

Nonetheless, to expedite examination and allowance of the claimed invention, Applicants have canceled Claims 72 and 73 and have rewritten Claims 55-65 and 68-71 to remove the intended use limitation and have written these claims as pharmaceutical preparations. Thus, this rejection is now believed to be moot.

In view of the foregoing, Applicants request withdrawal of this rejection.

The rejection of Claims 38-40, 51, 52, 55-57, 68, 69 and 72-74 under 35 U.S.C. §102(a) over Liu et al is respectfully traversed.

In the Office Action, the Examiner indicated that the benefit to priority has been denied because the priority applications (JP 2002-296468, JP 2003-278811 and JP 2003-285316) allegedly do not specifically support the exclusionary proviso and, thus, allegedly fails to provide written description support for the entire scope of the claims. Applicants disagree.

Applicants remind the Examiner that with respect to the analysis of negative limitations or exclusionary provisos under the written description requirement of 35 U.S.C. §112, first paragraph, the courts have acknowledged that any negative limitation or exclusionary proviso must have basis in the original disclosure (or in this case the priority application). The courts have further stated that if alternative elements are positively recited in the specification (priority applications), they may be explicitly excluded in the claims. See

In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). (See also MPEP §2173.05(i)).

With this in mind, Applicants submit that a pyridyl group is positively recited as an option at the position corresponding to substituent E in each of the three priority applications (JP 2002-296468, JP 2003-278811 and JP 2003-285316). As such, the priority applications do provide a sufficient written description requirement of 35 U.S.C. §112, first paragraph, to support the invention as claimed. As such, the rejection over Liu should be withdrawn.

Applicants request withdrawal of this rejection.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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